



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,832	03/15/2001	Robert A. Copeland	PH-7134	5618
23914	7590	11/20/2003	EXAMINER	
STEPHEN B. DAVIS BRISTOL-MYERS SQUIBB COMPANY PATENT DEPARTMENT P O BOX 4000 PRINCETON, NJ 08543-4000			RUSSEL, JEFFREY E	
			ART UNIT	PAPER NUMBER
			1654	

DATE MAILED: 11/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/808,832	Applicant(s) COPELAND ET AL.	
	Examiner Jeffrey E. Russel	Art Unit 1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 and 35-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-29 and 35-39 is/are allowed.
- 6) ☒ Claim(s) 40-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1654

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 8, 2003 has been entered.
2. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the following reasons:

The Sequence Listing filed October 8, 2003 is objected to because not all of the amino acid sequences disclosed in the specification and claims and subject to the sequence disclosure rules are recited in the Sequence Listing. For example, the elected sequence which was designated as SEQ ID NO:186 in the Sequence Listing filed June 28, 2001 does not correspond to SEQ ID NO:52 or to any other sequence of the Sequence Listing filed October 8, 2003. The elected sequence comprises 7 amino acids, i.e. the searchable sequence Xaa-Pro-Leu-Gly-Xaa-Tyr-Leu, and SEQ ID NO:52 of the Sequence Listing filed October 8, 2003 has only 4 amino acid residues. Modified and non-natural amino acids such as γ -E and O-benzyl-S are to be represented with the abbreviation Xaa (see 37 CFR 1.822(b)). They are not to be ignored and omitted from the sequence listing.

Applicant must provide a substitute computer readable form (CRF) copy of the Sequence Listing, a substitute paper copy of the Sequence Listing as well as an amendment directing its

Art Unit: 1654

entry into the specification, and a statement that the content of the paper and computer readable copies are the same and include no new matter as required by 37 CFR 1.825(a) and (b).

3. The disclosure is objected to because of the following informalities: SEQ ID NOS must be inserted after every amino acid sequence subject to the sequence disclosure rules. See 37 CFR 1.821(d). Such sequences are present, e.g., at pages 21, 22, 24, 26-34, 42, 43, and 48, and throughout the Examples of the substitute specification filed October 8, 2003. Further, of the amino acid sequences which are identified by SEQ ID NO, many do not correspond with the SEQ ID NO as defined in the Sequence Listing filed October 8, 2003. For example, at page 28, lines 3-5, the amino acid sequence comprising 5 amino acids does not correspond to SEQ ID NO:1 which only has 4 amino acids, none of which correspond to (N-Me-)L. Because of the number of paragraphs in the specification which will have to be amended in order to comply with this rule, Applicants are required to submit the corrections in the form of a substitute specification, including a marked-up copy and a statement of no new matter, in accordance with 37 CFR 1.121(b)(3) and 1.125(b). Appropriate correction is required.

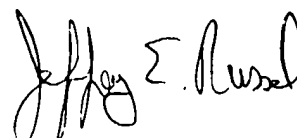
4. Claims 40-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 40-42 are indefinite because the amino acid sequence γ -E-P-L-G-(O-benzyl-S)-Y-L does not correspond with SEQ ID NO:52 as defined in the Sequence Listing filed October 8, 2003. Note that the sequence as recited in the claims comprises 7 amino acids, whereas SEQ ID NO:52 of the Sequence Listing filed October 8, 2003 has only 4 amino acid residues. Accordingly, it is not clear which amino acid sequence Applicants are requiring to be present as part of E^{cp}.

Art Unit: 1654

5. Applicants' amendments to the claims have overcome the prior art rejections set forth in the Office action mailed May 8, 2003. As a result, the election of species with respect to E^{CP} is withdrawn and the search has been extended to the full scope of the instant claims. Claims 1-29 and 35-39 are allowable. Claims 40-42 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey E. Russel at telephone number (703) 308-3975. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Brenda Brumback can be reached at (703) 306-3220. The fax number for Art Unit 1654 for formal communications is (703) 305-3014; for informal communications such as proposed amendments, the fax number (703) 746-5175 can be used. The telephone number for the Technology Center 1 receptionist is (703) 308-0196.



Jeffrey E. Russel

Primary Patent Examiner

Art Unit 1654

JRussel

November 18, 2003